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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,579	12/05/2003	Robert Mazur	208059.0003	1528

35614 7590 12/10/2004

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EXAMINER

MEISLIN, DEBRA S

ART UNIT PAPER NUMBER

3723

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,579

Applicant(s)

MAZUR, ROBERT

Examiner

Debra S Meislin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/5/03, 1/27/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Election was made **without** traverse in the reply filed on October 28, 2004.

Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

In claim 5, it is not clear as to how "the body supports piercing, tearing and cutting tools" is supported by the elected embodiment (or by any disclosed embodiment).

2. Claims 5, 18 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 5, "the body supports piercing, tearing and cutting tools" is not supported by the original disclosure.

In claim 18 and 20, "the first piercing tool is adapted for piercing, tearing and cutting" is not supported by the original disclosure.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6 and 15-18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Garby et al.

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5. Claims 1-2, 5-6 and 15-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Leu.

6. Claims 1-2, 6 and 15-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Penaligon et al.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garby et al in view of Borodulin.

Garby et al discloses all of the claimed subject matter except for having an elastomeric pad. Borodulin discloses an opener with an elastomeric pad. It would have been obvious to one having ordinary skill in the art to form the opener of Garby et al with an elastomeric pad to better grip the workpiece as taught by Borodulin.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garby et al or Fiocchi ('021 or '227) in view of Schulze.

Garby et al or Fiocchi ('021 or '227) disclose all of the claimed subject matter except for the device being formed of molded plastic. It would have been obvious to one having ordinary skill in the art to form the device of Garby et al or Fiocchi ('021 or '227) out of molded plastic for its known properties as taught by Schulze.

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10. Claims 1-7 and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite since the preamble defines a "container opener" while the body of the claim defines only "one or more pockets". The body of the claim fails to define that which is defined in the preamble of the claim.

In claim 1, "defines one or more pockets of various shapes" is misdescriptive since only more than one pocket can have various shapes.

In claim 5, it is not clear as to how "piercing, tearing and cutting tools" is supported by the elected embodiment (or by any disclosed embodiment).

Claim 7 is vague and indefinite since it does not depend from a previous claim.

In claim 17, "the body defines one or more tools releasing a vacuum pressure" is grammatically incorrect.

In claims 18 and 20, the disclosure lacks support for "tearing".

The term "template", in claims 1-7 and 14-20, is indefinite because the device does not define a "gauge or pattern" as is known in the template art. Additionally, if the template does define "a pattern of variously sized sockets" (as argued by applicant and unsupported by the specification), then the template cannot include a "pill splitting tool" since the "pill splitting tool" is not a pattern. Additionally, a pattern of variously sized sockets (template) is redundant with respect to "one or more pockets of various shapes". The specification defines "a template 18 that defines one or more variously sized pockets" and also "template 18 may also include a pill splitter". However, it is not

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clear as to the structure of a "template" since applicant is using contrary terminology. It is noted that removing the term "template" in the claims would provide a claim having the same scope.

11. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The description does not clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Applicant's arguments filed October 28, 2004 have been fully considered but they are not persuasive.

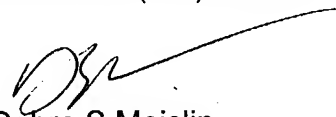
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Applicant's reference to "a pattern of variously sized pockets" is not supported by the disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Debra S Meislin
Primary Examiner
Art Unit 3723

December 7, 2004